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Scott Lascelles

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EXAMINER

MALHOTRA, SANJEEV

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/991,894	<b>Applicant(s)</b> LASCELLES ET AL.	
	<b>Examiner</b> SANJEEV MALHOTRA	<b>Art Unit</b> 3694	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 November 2009 and 14 July 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 and 18-24 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 18-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date : FIVE IDSs, one each filed on these dates: (07-27-2009, 12-11-2009, 01-06-2010, 02-03-2010, & 02-09-2010).

## **DETAILED ACTION**

### **Election Restriction and Status of Claims**

1. This Office Action is a non-final rejection on merits in response to the election of claims filed on November 25, 2009 for the original application filed on November 13, 2001 and titled: "On-line Balance Transfers".

Applicant's 'Response to Restriction Requirement' filed on November 25, 2009 is hereby entered. The election of Claims 1--13 ---forming Group I--- with traverse is acknowledged by the Examiner and hereby entered. Also, acknowledged is the non-election of Claims 14--16 and 18--24 forming Groups II--III that have been withdrawn. However, based on Applicant's arguments of November 25, 2009, Group II Claims 14-15 will now be examined along with Group I claims, since already conducted search by Examiner includes class 705, subclass 21 to which Group II claims are drawn as well as the limitations of Group II are almost identical to Group I claims with minor differences.

Accordingly, Claims 1--15 forming Groups I and II are now pending and are being examined herein.

Examiner notes that Claims 1, 2, 5, 6, 8, 10--13 and 14 have been currently amended per 'amendments to the claims' submitted on November 25, 2009. As noted in the previous Final Office Action mailed on January 14, 2009, the Applicant has still Not addressed the outstanding issue of the addition of new claims 18--24, because the REMARKS section filed on November 21, 2008 clearly stated on top of "Page 8 of 14" --  
- *"Claims 1-16 are pending in the application. Claim 17 has been cancelled without*

*prejudice.*” Examiner had sought clarification if any claims were being added, since Neither any mention had been made about the addition of new claims in Applicant’s remarks of November 21, 2008 Nor was there any detail provided about the support in the specification for the additional new claims 18-24 in the Applicant’s remarks, and hence, no entry of “new claims” 18-24 was made as noted in previous Final Office Action mailed out on January 14, 2009. In response, the Applicant in its remarks of July 14, 2009 stated {in curly brackets} that:- {Because claims 18-24 were previously submitted and were entered as of right, their status is indicated as “previously presented.”}, and Examiner respectfully disagrees as this response of Applicant is factually incorrect, because the New Claims 18-24, which are all dependent on independent Claim 16 directly or indirectly, were Not Entered as shown in Appendix to the Final Office Action mailed out on January 14, 2009 that clearly stated “Do NOT Enter ‘New Claims’ 18-24. /SM/” Twice on two pages --- before Claim 18 and after Claim 24. Hence, only Claims 1--15 are now being considered herein as the elected claims for prosecution by the Applicant. Examiner notes that once the Applicant addresses this outstanding issue of support for New Claims 18-24 in its Specification by providing line/paragraph numbers, the next Office Action may consider these claims.

2. Applicant's election with traverse of remaining Claims 16 and 18--24 in the reply filed on November 25, 2009 is acknowledged. The traversal is on the ground(s) that --- (i) the claimed inventions are neither independent nor distinct and do not have separate utility, and (ii) examination of Claims 16 and 18-24 in Group III does not create a serious burden. This is not found persuasive.

In regards to traversal (i), for simplicity of argument, assume all claim limitations in Group A (say in Group I) will be summarized as "AC", and all claim limitations in Group B (say in Group II) will be summarized as "BC". While Group B has some common and overlapping elements that were also in Group A (namely claim elements "C"), Group B has some different elements from Group A (namely claim elements "B"). It is extremely important to note that Applicants have failed to argue that Group A and Group B (or Groups I and II in the instant case) are not patentably distinct. Therefore, logic dictates that claim elements "B" in Group B must (by definition) contain patentably distinct features. Because of the mandatory electronic searches required for application allowance, the Examiner would be required to search for patentably distinct features of element "B" --- even if Group A was searched and considered allowed, for argument sake.

In the instant case, Groups I, II and III (independent claims and dependent claims in combination) contain overlapping claim elements and distinct claim elements. Therefore, the claimed inventions, despite overlapping claim elements, are still independent and distinct. Examiner notes, for example but not limited to, that the Applicant has not admitted in its November 25, 2009 response that remaining claims in Group III in Claims 16 and 18--24 do not include separate and distinct elements from Groups I and II claims, i.e., they are identical or same to the limitations in Group I (Claims 1-15). Additionally, Examiner notes that the Applicant is merely speculating in its November 25, 2009 response wherein it has stated that --- *"Furthermore, even if the separate subclassification for groups II and II (ED: should be Group III) is correct, no*

*serious burden has been shown in searching each of these two subclasses.*" (i.e., no undue burden on the Patent Examiner to search), and Examiner questions the basis for such a statement since neither the Applicant (nor the Examiner) has submitted any IDS/ Information Disclosure Statement form (or Form 892 by Examiner) of its own yet to show any search(es) conducted by the Applicant (or by the Examiner) so far for Group III claims.

Of course the Examiner's argument fails if the groups of inventions are not patentably distinct. If Applicants expressly state on the record in response to this Office Action and after each amendment hereafter that the two groups of inventions are not patentably distinct (for example, for Groups I and III) and makes amendments to either or both groups to make them identical, the restriction will be withdrawn in the following Office Action. (Also see the previous Election/Restriction Requirement mailed out on July 14, 2009, pages 5-8.) However, until the Applicants atleast make this written statement on the record, the requirement is still deemed proper and is therefore made FINAL.

In regards to traversal (ii), based upon the mandatory electronic searches required for application allowance, including internal database searches (e.g. patents, pre-grant publications) and external non-patent literature database searches (e.g. DIALOG), searching for additional patently distinct claim limitations would create an undue burden. Furthermore, the required searches would need to be sufficiently expansive and broad to account for the expansive and broad nature of the claim language utilized by the Applicant in describing the invention further compounding the

undue burden. Therefore, the requirement is still deemed proper and is therefore made FINAL.

Since the Applicant has received a requirement for restriction/election for the originally presented invention and has elected Group I, and Examiner has agreed to examine Group II with it, the remaining Claims 16 and 18-24 in Group III have been constructively withdrawn from consideration as being directed to a non-elected invention outside the scope of Groups I and II. *See 37 CFR 1.142(b) and MPEP § 821.03.*

## **Claim Objections**

3. Based on the Applicant's remarks, arguments and 'amendments to the claims' filed on November 25, 2009 and July 14, 2009, the previous Claim Objections are hereby withdrawn.

## **Claim Rejections - 35 USC § 112**

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Based on the Applicant's remarks, arguments and 'amendments to the claims' filed on November 25, 2009 and July 14, 2009, the previous Claim Objections for Claims 1--15 listed from (a.) to (II.) and new ones listed as (i) to (vi) in the previous Final Office Action are hereby withdrawn. However, there is still one pending rejection (mm.) for independent Claim 14 as follows ---



mm. Still Pending: Independent Claim 14, as amended, recites the limitation “the received balance transfer request” in line 15 that is indefinite. Because there is insufficient antecedent basis for this limitation in the claim. Additionally, Examiner seeks clarification how it is different from the recitation of “the online balance transfer request” in line 14 of this Claim?

Examiner notes that ‘amendments to the claims’ filed on November 25, 2009 shows the word “received” as underlined to show that it was added as part of the amendments to read as --- “process the online balance transfer request if all eligibility requirements are met and, otherwise, not processing the received balance transfer request;”, but that is incorrect. Examiner notes that atleast this word “received” was already recited in Claims filed in claims a year earlier on November 21, 2008 as in this limitation:- *“process the online balance transfer request if all eligibility requirements are met and, otherwise, not processing the received balance transfer request;”*, and that these two limitations filed a year apart are identical. Examiner has considered this error to be a typographical error, and hence, a Notice of Non-Responsive Amendment was not sent out. However, the Applicant’s cooperation is sought in correcting similar errors that the Applicant may become aware of and notifying the Office of such corrections.

*Appropriate correction is required.*

New Claim Rejection under 35 USC 112, second paragraph ---

(A) Claim 3, line 3 recites the limitation “the account data” that is indefinite and/or unclear. Because there is insufficient antecedent basis for this limitation in the claim.

Additionally, Examiner seeks clarification as to which “account data” is being referenced herein in line 3 of Claim 3, is it “the first credit account data” or “the second credit account data”? Examiner suggests that Claim 3 be amended in a manner similar to what has been done in amending Claim 2, line 3 by adding “associated with the first credit account” after the phrase “the account data”.

*Appropriate correction is required.*

Applicant’s cooperation is requested in correcting the claims to overcome the above described Claim Rejections as well as any other corrections that the Applicant might become aware of in formulating its reply.

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15, as amended, are rejected under 35 USC 103(a) as being unpatentable as described below for each claim/limitation.

Independent Claim 1 is rejected under 35 USC 103(a) as unpatentable over Patent No. US 5,590,038 issued to Pitroda, Satyan G. filed on June 20, 1994 and titled: “Universal Electronic Transaction Card including Receipt Storage and System and Methods of Conducting Electronic Transactions” (hereinafter “Pitroda”) in view of US Patent No. 5,453,601 issued to

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Rosen, Sholom S. for an application filed on November 15, 1991 and is titled: "Electronic-Monetary System" (hereinafter "Rosen"), and further in view of US Patent No. 6,267,292 issued to Walker et al. filed on July 22, 1999 claiming priority from June 13, 1997 and titled: "Method and Apparatus for Funds and Credit Line Transfers" (hereinafter "Walker").

Examiner notes that teachings in the patent issued to Pitroda include as stated in its Abstract --- "A universal electronic transaction card ("UET card") is capable of serving as a number of different credit cards, bank cards, identification cards, employee cards, medical cards and the like. The UET card includes information storage elements, an input interface, a processor, a display, and a communications interface. In a preferred embodiment, the display is a touch-sensitive display which provides the user with a number of graphical images which enable the user to selectively choose the type of "credit card" to use for a transaction, and to then choose a particular credit card to use with the transaction. After the choice is made, a graphic image appears on the display which looks like the face of a plastic credit card, including the account number, the user's name, the name of the credit card company and its logo. Thereafter, the user presents the UET card to the point of sales terminal for a sales transaction. After proper verification with the main computer of the service provider, the sales transaction information is transferred and stored in the UET card by the point of sales terminal to eliminate paper receipts and facilitate future storage, verification and analysis for billing, budgeting and financial management and using a home or office personal computer or other facilities. The invention also includes methods of issuing account authorization to a UET card, a method of transferring transactional and account information between a UET card and a personal computer or mainframe computer, a method of using the UET card as a remote terminal for a mainframe computer, and a method of conducting an electronic transaction."

With respect to Claim 1, Pitroda teaches "A computer implemented method for online transfer of a balance from a first credit account associated with an account holder to a second credit account associated with the account holder comprising:" (see at least Pitroda Abstract and Summary)

"receiving at a computer a balance transfer request for transferring a balance from the first credit account to the second credit account;" (see at least Pitroda Abstract and Summary, and

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C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“obtaining account data associated with the first credit account, said account data comprising at least an identifier for a first financial institution with which the first credit account is held;” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“determining using with a business logic server, using the account data associated with the first credit account, whether the first financial institution with which the first credit account is held is related to a second financial institution with which the second credit account is held;” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about ‘related’ financial institutions. However, Rosen teaches it. (see at least Rosen Abstract and Summary, and C 25, ~L 28 to 58)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the teachings of Rosen. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

“processing the balance transfer request if it meets all of at least one eligibility requirement for transferring the balance, and otherwise not processing the balance transfer request; the at least one eligibility requirement comprising a requirement that the first credit account as being not eligible for a balance transfer to said second credit account if it is determined that the first credit account and the second credit card account not be held by related financial institutions.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about ‘not to be held by related financial institutions’. However, Rosen teaches it explicitly. (see at least Rosen Abstract and Summary, and C 25, ~L 28 to 58)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the teachings of Rosen. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

Pitroda and Rosen teach as disclosed above, but it may be argued that they do Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and

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C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda and Rosen with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

*Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”*

Dependent Claims 2-13 are rejected under 35 USC 103(a) as unpatentable over Pitroda in view of Walker as applied to the rejection of independent Claim 1 above.

With respect to Claim 2, Pitroda teaches “wherein the account data associated with the first credit account is obtained in real time.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 3, Pitroda teaches “wherein the account data is obtained from a source other than the account holder.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 4, Pitroda teaches “wherein the source other than the account holder is a credit reporting bureau.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 5, Pitroda teaches “wherein the first and second financial institutions are identical.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

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It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

*Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”*

With respect to Claim 6, Pitroda teaches “wherein the first financial institution is considered related to the second financial institution if the first financial institution is affiliated with the second financial institution.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

*Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”*

With respect to Claim 7, Pitroda teaches “wherein determining whether the first financial institution is related to the second financial institution comprises comparing the first financial institution with a list of ineligible financial institutions.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about

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balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

*Examiner notes that Walker explicitly teaches about balance transfer and states that "it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account."*

With respect to Claim 8, Pitroda teaches "wherein the list of ineligible financial institutions comprises the second financial institution and any financial institutions associated with the second financial institution with which the second credit account is held." (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

*Examiner notes that Walker explicitly teaches about balance transfer and states that "it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account."*

With respect to Claim 9, Pitroda teaches "receiving from the account holder an indication that the account holder is interested in transferring a balance to the second credit account;" (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

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“wherein obtaining account data is performed in response to receiving said indication.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

*Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”*

With respect to Claim 10, Pitroda teaches “further comprising displaying at least a portion of said account data associated with the first credit account to the account holder.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 11, Pitroda teaches “further comprising displaying at least a portion of said account data associated with the first credit account to the account holder in the event it is determined that the first financial institution is not the same as or affiliated with the second financial institution.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

With respect to Claim 12, Pitroda teaches “providing to the account holder a balance transfer request display, the balance transfer request display comprising a data entry field;” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“populating the data entry field with at least one element of said account data associated with the first credit account.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)



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With respect to Claim 13, Pitroda teaches “providing to the account holder a balance transfer request display, the balance transfer request display comprising a data entry field;” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“in the event it is determined that the first financial institution is not the same as or affiliated with the second financial institution, populating the data entry field with at least one element of said account data associated with the first credit account.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

*Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”*

Independent Claim 14 is rejected under 35 USC 103(a) as unpatentable over Patent No.

US 5,590,038 issued to Pitroda, Satyan G. filed on June 20, 1994 and titled: “Universal

Electronic Transaction Card including Receipt Storage and System and Methods of Conducting

Electronic Transactions” (hereinafter “Pitroda”) in view of US Patent No. 6,267,292 issued to

Walker et al. filed on July 22, 1999 claiming priority from June 13, 1997 and titled: “Method

and Apparatus for Funds and Credit Line Transfers” (hereinafter “Walker”).

With respect to Claim 14, Pitroda teaches “A system for online transfer of a balance comprising: a computer system configured to:” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

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“receive an online balance transfer request for transferring a balance from a first credit account associated with an account holder to a second credit account associated with the account holder;” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“obtain account data associated with the first credit account, said account data comprising at least information identifying a first financial institution with which the first credit account is held;” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“determine whether the online balance transfer request meets at least one eligibility requirement, the at least one eligibility requirement comprising a requirement that the first financial institution with which the first credit account is held is not related to a second financial institution with which the second credit account is held;” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“process the online balance transfer request if all eligibility requirements are met and, otherwise, not processing the received balance transfer request;” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

“a network connection associated with the computer system and configured to enable the computer system to receive data transmissions from and send data transmissions to the account holder.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

Pitroda teaches as disclosed above, but it may be argued that it does Not explicitly teach about balance or debt transfer from one account to another by the same credit card holder. However, Walker teaches it explicitly. (see at least Walker Abstract and Summary, and C 2, ~L 20-30)

It would have been obvious to an ordinary person of skill in the art at the time invention was made to modify the teachings of Pitroda with the explicit teachings by Walker about balance or debt transfer from one account to another by the same credit card holder. The motivation to combine these two references would be to provide a more efficient and effective system and method for making electronic transfer of balance or debt from one account to another by the same credit card holder, and thus increase manageability of their debt by the account holder(s).

*Examiner notes that Walker explicitly teaches about balance transfer and states that “it is well known in the art that credit card holders are free to transfer debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such transfers are typically done by paying off the old account with a convenience check or electronic funds transfer, which draws the old account balance onto the new credit card account.”*

Dependent Claim 15 is rejected under 35 USC 103(a) as unpatentable over Pitroda in

view of Walker as applied to the rejection of independent Claim 14 above.

With respect to Claim 15, Pitroda teaches “wherein said computer system comprises two or more computers.” (see at least Pitroda Abstract and Summary, and C 13, ~L 22 to C 14, ~L 65, and C 15, ~L 12 to C 17, ~L 37)

## **Response to Arguments**

6. Applicant's Remarks and Arguments dated November 25, 2009 and July 14, 2009 with respect to the rejection of amended Claims 1-16 have been carefully considered, but they are not persuasive. Additionally, Examiner notes that with the Applicant's ‘amendments to the claims’, Examiner respectfully disagrees with the arguments submitted by the Applicant and the rejection of elected and amended Claims 1-15 under 35 USC 103(a) and 35 USC 112 is being maintained with some modifications in this Office Action, where needed, to provide clarification.

Additionally, Examiner notes that Applicant's ‘amendments to the claims’ and/or arguments necessitated the new ground/s of rejection (e.g., Rosen). As noted above in respective sections, Examiner has Withdrawn all of the Claim Objections, and almost all of the 35 USC 112, second paragraph rejections except one based on the amendments and/or clarifications submitted by the Applicant upto November 25, 2009.

Examiner respectfully suggests that the Applicant may consider revising the currently recited claims language. Examiner notes that the Court of Appeals for the Federal Circuit (CAFC) has noted that claims were held indefinite in such circumstances. If the language of a claim, considered as a whole in light of the specification and given its broadest reasonable interpretation, is such that a person of ordinary skill in the relevant art would read it with more

than one reasonable interpretation, then a rejection of the claim under 35 USC 112, second paragraph is appropriate. (see MPEP 2173.05 (a), also see MPEP 2143.03 subsection I and MPEP 2173.06) Where the claim is subject to more than one interpretation and at least one interpretation would render the claim indefinite over the prior art, examiner should reject the claim as indefinite under 35 USC 112, second paragraph and should reject the claim over prior art based on interpretation of the claim that renders the prior art applicable. (see MPEP 2173.05 (a), also see MPEP 2143.03 subsection I and MPEP 2173.06)

Examiner notes that in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the Applicant is informed that the references cited in the rejection of claims must be read in entirety as other passages and drawings may also apply.

In response to Applicant's amendments to independent Claims and arguments against the 35 USC 103 rejection, Examiner notes that when combining references for rejection under 35 USC 103, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to the Applicant's arguments against the Pitroda reference that it only teaches about the Universal Electronic Transaction (UET) Card, Examiner notes that Pitroda also teaches

about system and methods of conducting electronic transactions as reflected in its title and as shown from the following paragraphs about transferring account information (in its Summary)---

"This invention also includes a method of ~~transferring~~ account information and accumulated transactional information for a plurality of credit transactions for a service institution account from a UET card to a personal computer. The method comprises the steps of establishing an electronic communication between a personal computer and a UET card; selecting at least one service institution account; selecting from the at least one service institution account credit transactions for such account which were transacted in a predetermined period of time; and, transmitting from the universal electronic transaction card the selected credit transactions to storage means in a personal computer. The selected credit transactions may thereafter be displayed on the personal computer in the form of a monthly statement of the type normally provided on paper by the service institution."

and another paragraph in Pitroda's Summary ---

"There are several advantages to the present invention. With respect to credit card transactions, the UET card of the present invention may be used to store in memory each credit card or bank transaction for which it is used. Those transactions may be displayed on the display of the UET card. Alternatively, the

contents of memory may be electronically **transferred** to a personal computer for use in any one of a number of commercially available personal accounting programs, such as the program commercially sold under the name "QUICKEN". Alternatively, the information could be used with spreadsheet programs, such as LOTUS or EXCEL. Alternatively, the UET card may be provided with a disk containing a program that may be used on a personal computer to display and print the information. Or, for those card users who might not own a personal computer, a printer may be provided to interface with the card and to print the record of the desired transaction or transactions."

Additionally, examiner notes that Walker teaches about transfer of balance/debt as in ---  
"Credit cards today have become a pervasive method of payment for goods and services. They not only offer convenience, security, and flexibility in the commercial transaction process, but also provide some limited flexibility in the assignment of debt obligation. For example, it is well known in the art that credit card holders are free to **transfer** debt between accounts, thereby taking advantage of different account features, such as lower interest rates. Such **transfers** are typically done by paying off the old account with a convenience check or

electronic funds **transfer,** which draws the old account **balance** onto the new credit card account."

## Conclusion

7. The prior art made of record and not relied upon that is considered pertinent to the Applicant's disclosure and review for not traversing already issued patents by the claims of the current invention of the Applicant:

- US Patent No. 5,857,079 issued to Claus et al. filed on December 23, 1994 and titled: "Smart Card for Automatic Financial Records".
- US Patent No. 6,044,360 issued to Picciallo, Michael J. filed on June 16, 1997 that is claiming priority from April 16, 1996 and titled: "Third Party Credit Card".

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanjeev Malhotra whose telephone number is 571-272-7292. The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/

Primary Examiner, Art Unit 3694

/SM/

19 MARCH, 2010